

### **REMARKS**

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1, 3-11, 13-15 and 17-28 are now present in this application. Claims 1, 8, 13, 17 and 22 are independent. By this Amendment, claims 12 and 16 are canceled, claims 13 and 17 are re-written in independent form, and claims 18 and 20 are amended to change their dependency so that they do not depend from a canceled claim. No new matter is involved.

It is proper to enter these amendments because they reduce and simplify issues for appeal and require no further consideration and/or search, and because the rejection should not have been made final.

### **PREMATURE FINAL REJECTION**

The Office Action provides a new ground of rejection for the first time despite the fact that the claim language in issue has not been amended in any way from the way it appeared when this Application was filed.

The rejection of claim 1, as amended to include the subject matter of (now canceled) claim 2, states for the first time that "the structure including a ball bearing, housing, and shaft have been included in the independent claims 1 and 8, however, there is no connection of this structure to the claimed function."

This subject matter was always in claim 2 and whether it was in claim 2 as depending from claim 1, or whether it was added into claim 1, it was always present in the pending claims under rejection.

Raising it now, for the first time, means that this Office Action cannot properly close prosecution. Applicants have a right to respond to this completely new ground of rejection on the merits and have the right to more than just a cursory Advisory Action. Instead, they are entitled to withdrawal of the finality of this Office Action and a full treatment of this argument on the merits in the next Office Action, as required by MPEP §707.07(f).

Accordingly, withdrawal of the finality of the outstanding Office Action is respectfully requested.

**REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

Claims 1 and 3-11 stand rejected under 35 U.S.C. § 112, second paragraph, for omitting essential elements, such omissions amounting to a gap between the elements, citing MPEP §2172.01. Applicants respectfully traverse this rejection.

The Office Action asserts that the omitted elements are the elements of the rear hinge that provide the claimed functions, and the elements of the front hinge that rotatably support the front of the drum.

Applicants respectfully disagree with this assertion for a number of reasons.

Firstly, claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. *See In re Venezia*, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976). In that case the court did not require *Venezia's* claims to recite his elements as being interconnected. Applicant's claims recite a slot feature structure, and only need to recite those elements which distinguish the invention from the prior art. The definiteness of claim language is analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing ordinary skill in the pertinent art, *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Furthermore, the Applicants may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. *See in this regard, In re Swinehart*, 439 F.2d 210, 160 226 (CCPA 1971).

The recitation in the claims of the various recited elements is clear, and one of ordinary skill in the art can readily determine the metes and bounds of the invention without any further recitations.

The test for compliance with the second paragraph of 35 U.S.C. § 112, as stated in *Miles*

Lab., Inc. v. Shandon Inc., 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993), cert. denied, 510 U.S. 1100 (1994) is whether one skilled in the art would understand the bounds of the claims when read in light of the specification. If the claims, read in light of the specification, reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no more. *See also*, In re Merat, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975), which stated that the question under Section 112, second paragraph is whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bonds of the claimed subject matter are distinct. *See also*, In re Warmerdam, 33 F3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

The second paragraph of 35 U.S.C. § 112 requires claims to be set out and circumscribe a particular area with a reasonable degree of precision and particularity, In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977).

All of Applicants' claims satisfy these requirements.

Moreover, the case cited in MPEP §2172.01 (on which this rejection is based) to require inclusion of essential structural cooperative relationships, In re Mayhew, 188 USPQ 356 (CCPA 1976), has been severely limited by the decisions of the Federal Circuit regarding the very similar Gentry Gallery case, cited below.

This Application is unlike the application in Gentry Gallery, Inc. v. Berkline Corp., 43 USPQ2d 1498 (Fed. Cir. 1998) in which the court's determination that the patent disclosure did not support a broad meaning for the disputed claim was premised on clear statements in the written description that described the location of a claim element - the "control means" - as "the only possible location" and that variations were "outside the stated purpose of the invention", *Id.* at 1503. The Federal Circuit subsequently held, in Johnson Worldwide Associates Inc. v. Zebco Corp., 50 USPQ2d 1607 (Fed. Cir. 1999) that Gentry Gallery considers the situation where the patent's disclosure makes it crystal clear that a particular (i.e., narrow) understanding of a claim term is an "essential element of [the inventor's] invention." Applicants submit that this decision also limited the applicability of the In re Mayhew decision.

In this regard, Applicants' disclosure never states, or otherwise admits, that any particular

feature is an essential element of the invention. Absent such an admission, there is no statutory basis to make the requirements set forth in this rejection under 35 U.S.C. § 112. Accordingly, this rejection of claims 1 and 3-11 is improper and should be withdrawn.

Applicants respectfully submit that this rejection improperly equates claim scope with indefiniteness and amending the claims to include additional features of the front hinge and the rear hinge will not clarify the metes and bounds of the claims, which are clear already.

The outstanding Office Action does not respond to or treat in any way the previous two paragraphs, both of which were presented in the Reply filed on March 19, 2006 in contravention of the requirement to fully address those arguments in MPEP §707.07(f). For this reason alone, the outstanding Office Action is improper and should be withdrawn.

The outstanding Office Action states that Applicants merely argue case law and “does not apply to the instant application.” Applicants respectfully disagree with this statement. The case law that is cited and discussed by Applicants reinforces Applicants’ position that Applicant’s currently pending claims fully comply with the requirements of 35 USC §112, second paragraph, and set forth what that statute requires based on existing case law. Applicants point out, by citing more recent case law, that the case law on which the rejection is based has been severely limited and does not require Applicants to add any allegedly essential features to its currently pending claims because Applicants have not indicated in their disclosure that the allegedly missing essential features are essential to Applicants’ invention. Applicants also cite case law that points out that the claims need only define the metes and bounds of the invention with reasonable clarity. Applicants need not elaborate any further on this because the Office Action does not allege that the claim language does not define the metes and bounds of the invention with reasonable clarity. Instead, the rejection is based on application of a principle that has been severely limited and does not apply to this Application for reasons presented in the traversal of this rejection.

Applicants have not “merely cited case law and not applied it to the claims.” Applicants have cited case law indicating what 35 USC §112, second paragraph requires, and the Office Action itself has not argued that the claims violate the principles set forth in that case law, which is evidence that the basis of the rejection is improper and is another reason why this rejection should

be withdrawn.

The outstanding Office Action states, for the first time, that whereas the structure including a ball bearing, housing and shaft have been included in the independent claims 1 and 8, there is no connection of this structure to the claimed function.

In response to this new ground of rejection, Applicants respectfully submit that these three elements are not being claimed in “means-plus-function” format (compare, 35 USC §112, sixth paragraph) and, as such, do not need to recite a particular function. All that the claimed language in issue needs to do is to make the metes and bounds of the invention clear, and these claimed features do exactly that. The Office Action does not contend otherwise.

Accordingly, the Office Action fails to provide objective factual evidence that the claims under rejection fail to comply with 35 USC §112, second paragraph.

Reconsideration and withdrawal of this rejection of claims 1 and 3-11 are respectfully requested.

#### **RESTRICTION/ELECTION BY PREVIOUS PRESENTATION**

The outstanding Office Action has withdrawn claims 22-28 from consideration, stating that they are directed to a distinct method of fabricating a hinge apparatus, i.e., an invention that is independent and distinct from the originally claimed invention, which is directed to a hinge apparatus.

Unfortunately, the Office Action completely fails to provide any objective support for this conclusion that these inventions are independent and distinct, or to otherwise justify the merits of this restriction and withdrawal of claims 22-28 from consideration on their merits, in contravention of the requirement to do so in MPEP Chapter 800. This also denies Applicants fundamental substantive and procedural due process under the Administrative Procedures Act. *See* in this regard, *In re Zurko*, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and *In re Gartside*, 53 USPQ2d 1769 (Fed. Cir. 2000). For these reasons alone, the holding of election by previous presentation and the withdrawal of claims 22-28 is improper.

In order to make a proper holding of election by previous presentation, the Office Action

has to establish (not just merely conclude) that (1) the inventions are independent (see MPEP §§802.01, 806.06, 908.01) and distinct as claimed (see MPEP §§806.05 through 806.05(j)); and (2) there would be a serious burden on the Examiner if restriction is not required, as set forth in MPEP §803, Section I., found on page 800-4 of the MPEP, Revision 3, dated August 2005.

Because the requirements of the MPEP have not been complied with, this restriction and holding of election by previous presentation and withdrawal of claims 22-28 from consideration on their merits is improper, must be withdrawn, and claims 22-28 should be examined on their merits.

Reconsideration, withdrawal of this holding of restriction/election and examination of claims 22-28 on their merits are respectfully requested.

Applicants also note that if a restriction requirement is made in the next Office Action and grounds are presented to support it for the first time, it will not be proper to make that next Office Action final.

### **REJECTION UNDER 35 U.S.C. § 102**

Claims 8-10 and 12-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,483,756 to Heyder. This rejection is respectfully traversed.

Anticipation under 35 U.S.C. § 102(b) requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of

circumstances is not sufficient." *Id.* at 1269, 20 USPQ2d at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981)).

This rejection is moot with respect to claims 12 and 16, which have been canceled.

Claims 8-10 positively recite a combination of features, including a base nut having a disc-shape installed at a nut-installed portion formed at the case, and a disc-shape is a thin circular or round flat plate shape, and the unlabeled element, e.g., coupling, between hex nut 4 and ball bearing 5 most certainly does not have a thin circular or round flat plate type shape. In response to this argument, the outstanding Office Action states that the term "thin" is a relative term and the unlabeled element includes flat surfaces. What these assertions overlook is that the unlabeled element of Heyder located between nut 4 and ball 5 has two distinct portions, i.e., a large diameter portion and a narrower portion extending perpendicularly to the larger diameter portion, as shown in Fig. 3, and appears to be nothing more than an elongated guide or hub that has no threads, which are a required part of a nut.

Nor is the single fastening part or contact pin guide 22 a plurality of engaging portions formed at a certain interval in a circumferential direction of the base nut.

The outstanding Office Action does not respond to this previously presented argument, as required by MPEP §707.07(f). As such, this arguments is admitted.

Accordingly, the Office Action fails to provide a *prima facie* case that Heyder anticipates claims 8-10.

Furthermore, with respect to claim 10, element 23 in Heyder is a contact pin, to establish galvanic contact with housing parts – see col. 4, lines 1-17, and not to stop any stopping protrusion, a feature which is also not disclosed by Heyder. In this regard, element 22 in Heyder is not a stopping protrusion. Rather, it is merely an electrical contact pin guide, as disclosed in col. 4, lines 11-17.

In response to this previously presented argument, the outstanding Office Action states that element 22 is an engaging protrusion that is stopped by stopping pin 23. Applicants respectfully disagree with this interpretation of Heyder and submit that element 22 is only disclosed as a pin guide of bearing journal 3 and is not disclosed as being moved whatsoever.

With respect to independent claims 13 and 17 (and dependent claims 14-15 and 18-21), the outstanding Office Action argues that the claimed reinforcing member is back wall 1. However, back wall 1 is mounted on an inner surface of the dryer case/housing 2, whereas what is claimed as a reinforcing member mounted at an outer surface of the case. Additionally, the Office Action alleges that element 23 of Heyder (which is merely disclosed as a galvanic contact pin which is part of a galvanic connection – see col. 4, lines 11-17 of Heyder), is a stopping pin. Unfortunately, there is no disclosure in Heyder that galvanic contact pin 22 stops anything, let alone the claimed stopping protrusions, which are also not disclosed by Heyder.

Further, with respect to claims 14 and 15, element 23 of Heyder is not disclosed as a stopping pin, as alleged in the rejection, and does not stop its own case 22, which is incorrectly characterized in the rejection as a stopping protrusion. The Office Action does not state what is stopped by element 22, and Applicants cannot find any evidence in Heyder that element 22 is a stopping protrusion or stops anything.

Further, with respect to claims 17 and 18, the unlabeled element between elements 4 and 5 of Heyder is not threaded and, thus, cannot be a nut or a base nut member, and is not disclosed as screw-engaged with the shaft. Nor is the back wall 1 located at an outer surface of case 2, as recited.

Further, with respect to claims 19 and 20, what is identified in the Office Action as a base nut member does not have a disc shape, as explained above in traversal of the rejection of claims 8-10, element 23 of Heyder is not a stopping pin and element 22 of Heyder is not a stopping protrusion.

Accordingly, the Office Action fails to make out a *prima facie* case of anticipation of claims 8-10 and 12-20 under 35 U.S.C. § 102(b) by Heyder.

Reconsideration and withdrawal of this rejection of claims 8-10 and 12-20 are respectfully requested.

**REJECTION UNDER 35 U.S.C. § 103**



Claims 1 and 3-7 stand rejected under 35 USC §103(a) as unpatentable over Heyder in view of U.S. Patent 5,251,859 to Cyrell et al. ("Cyrell"). This rejection is respectfully traversed.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole," not just a few features of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. *See In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. *See Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal Inc. v. E-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the

modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See *In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

The Office Action admits that Heyder does not disclose a shaft extending entirely through the ball bearing. In an attempt to remedy this shortcoming of Heyder, the Office Action turns to Cyrell.

Cyrell discloses an adjustable support mount for a load O, such as an audio speaker, the mount having a clamp plate 12, a clamp plate extension 14 and a fulcrum 16 and a removable jaw plate 20. The ball of the shaft is mounted on a hollow shaft 34 having an end 36 that is disclosed as being somewhat recessed from the ball's surface to form a hollow. This hollow

allows the ball to turn further and articulate more within the socket without obstruction from the nearby shaft end 36.” *See*, for example, col. 4, lines 13-21 and 52-65 of Cyrell.

In other words, Cyrell not only does not disclose a ball joint ball in which a shaft extends completely through the ball, as recited but, in fact, Cyrell explicitly discloses that its shaft 34 is designed not to extend completely through the ball but, instead, to deliberately be recessed from going entirely through the base to form a hollow that is very beneficial to the operation of Cyrell’s device.

Accordingly, even if one of ordinary skill in the art were properly motivated to modify Heyder in view of Cyrell (which is not the case, for reasons discussed, below) the resultant modified version of Heyder would not result in, or render obvious the claimed invention.

Moreover, the Office Action fails to present objective factual evidence of proper motivation to modify Cyrell, as suggested.

The rationale for motivating a skilled worker to make the proposed modification of Heyder in view of Cyrell is Cyrell’s disclosure of allowing access to the shaft, as disclosed in col. 4, lines 56-59 of Cyrell.

Applicants respectfully disagree. In this regard, the only access that is discussed by Cyrell is access to the tubular interior of Cyrell’s shaft 34 that is used as a conduit for electrical wires, presumably for the audio speaker disclosed in col. 3, lines 10-13. However, that is irrelevant to Heyder because Heyder does not have a hollow shaft that acts as a conduit for wires. Accordingly, one of ordinary skill in the art would not look to modify Heyder’s solid journal 3 because of ease of access to the hollow conduit of Cyrell.

Accordingly, the Office Action fails to present a *prima facie* case of obviousness of the claimed invention based on Heyder in view of Cyrell.

Reconsideration and withdrawal of this rejection of claims 1 and 3-7 are respectfully requested.

Claims 11 and 21 stand rejected under 35 USC §103(a) as unpatentable over Heyder in view of U.S. Patent 5,963,432 to Crowley. This rejection is respectfully traversed.

Initially, Applicants respectfully submit that claim 11 depends from claims 8 and 9, and that claim 21 depends from claims 17 and 18 and that the subject matter of claims 8, 9, 17 and 18 is not anticipated by Heyder for reasons discussed above regarding the traversal of the rejection of claims 8, 9, 17 and 18 as anticipated by Heyder. Moreover, Crowley is not applied to remedy the deficiencies in Heyder. Accordingly, even if one of ordinary skill in the art were properly motivated to modify Heyder in view of Crowley to substitute a weld or a rivet for Heyder's nut 4, the resulting modified version of Heyder would not render the claimed invention obvious.

Moreover, the Office Action does not provide objective factual evidence that the teaching of equivalence of a threaded rod and nut, adhesive, rivet or clamp in the printed circuit board standoff art would motivate one of ordinary skill in the art to substitute a rivet or a weld for the hex nut-bearing journal arrangement of Heyder, especially where the bearing journal of Heyder is threaded and doing away with it would do away with this fundamental feature of Heyder's invention would probably make Heyder's clothes dryer inoperative.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of claims 11 and 21 under 35 U.S.C. § 103(a) by Heyder in view of Crowley.

Reconsideration and withdrawal of this rejection of claims 11 and 21 are respectfully requested.

### **CONCLUSION**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Accordingly, Applicants respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn.

Applicants also respectfully request that the finality of this office Action be withdrawn, and that the restriction/election by previous presentation be withdrawn, and claims 22-28 be examined on their merits in the next Office Action.

It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

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If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By

  
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